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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,709	02/19/2002	Robert F.M. Van Gorcom	246152002603	9896

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EXAMINER

STEADMAN, DAVID J

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 04/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/079,709	VAN GORCOM ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	David J Steadman	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 32-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 32-47 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

**DETAILED ACTION**

***Status of the Application***

- [1] Claims 32-47 are pending in the application.
- [2] Applicants' amendment to the specification, cancellation of claims 1-31, and addition of claims 32-47 in the preliminary amendment filed February 19, 2002 is acknowledged.
- [3] The specification is objected to as applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows: An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78).

If applicant desires priority under 35 U.S.C. 120 based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. \_\_\_\_\_" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

***Election/Restrictions***

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- [4] Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claim(s) 32-43 and 47, drawn to a purified and isolated DNA that hybridizes to SEQ ID NO:25, a recombinant expression system, a recombinant vector, a recombinant microbial host cell, and a method of expressing a nucleotide sequence encoding a fungal phytase, classified in class 435, subclass 196.
  - II. Claim(s) 32-43 and 47, drawn to a purified and isolated DNA that hybridizes to SEQ ID NO:26, a recombinant expression system, a recombinant vector, a recombinant microbial host cell, and a method of expressing a nucleotide sequence encoding a fungal phytase, classified in class 435, subclass 196.
  - III. Claim(s) 32-43 and 47, drawn to a purified and isolated DNA that hybridizes to SEQ ID NO:27, a recombinant expression system, a recombinant vector, a recombinant microbial host cell, and a method of expressing a nucleotide sequence encoding a fungal phytase, classified in class 435, subclass 196.
  - IV. Claim(s) 32-33, drawn to a purified and isolated DNA that hybridizes to nucleotides 210-1715 of SEQ ID NO:31, classified in class 536, subclass 23.2.
  - V. Claim(s) 44-46, drawn to a method to identify nucleic acids that encode compounds having phytase activity by assessing its ability to hybridize to SEQ ID NO:25, classified in class 435, subclass 6.

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**VI.** Claim(s) 44-46, drawn to a method to identify nucleic acids that encode compounds having phytase activity by assessing its ability to hybridize to SEQ ID NO:26, classified in class 435, subclass 6.

**VII.** Claim(s) 44-46, drawn to a method to identify nucleic acids that encode compounds having phytase activity by assessing its ability to hybridize to SEQ ID NO:27, classified in class 435, subclass 6.

**[5]** The inventions are distinct, each from the other because:

**[6]** The nucleic acids of Groups I-IV are structurally distinct and no single nucleic acid of Groups I-IV would render any of the others obvious to one of ordinary skill in the art.

**[7]** The polynucleotide of Group I and the method of Group V, the polynucleotide of Group II and the method of Group VI, and the polynucleotide of Group III and the method of Group VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotides of Groups I-III can be used as a template for polymerase chain reaction.

**[8]** The nucleic acid of Group I is unrelated to the method(s) of Groups VI-VII as it is neither used nor made by the method(s) of Groups VI-VII.

**[9]** The nucleic acid of Group II is unrelated to the method(s) of Groups V and VII as it is neither used nor made by the method(s) of Groups V and VII.

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**[10]** The nucleic acid of Group III is unrelated to the method(s) of Groups V-VI as it is neither used nor made by the method(s) of Groups V-VI.

**[11]** The nucleic acid of Group IV is unrelated to the method(s) of Groups V-VII as it is neither used nor made by the method(s) of Groups V-VII.

**[12]** The methods of Groups V-VII are independent as they utilize different products.

**[13]** MPEP § 803 sets forth two criteria for a proper restriction between patentably distinct inventions: (A) The inventions must be independent or distinct as claimed and (B) There must be a serious burden on the examiner. As shown above, each of the inventions of Groups I-VII are independent or distinct, thus satisfying the first criterion for a proper restriction. MPEP § 803 additionally states that a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search. Each of the inventions requires a separate patent and non-patent literature search requiring a different text and/or sequence search for each Group and thus, co-examination of the inventions of Groups I-VII would place a serious burden on the examiner.

**[14]** Claims 32-47 will be examined only to the extent the claims read on the elected subject matter.

**[15]** Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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[16] Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Rejoinder***

[17] The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims

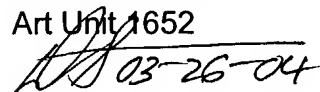
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and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder.

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934. The Examiner can normally be reached Monday-Friday from 7:00 am to 5:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX number for submission of official papers to Group 1600 is (703) 308-4242. Draft or informal FAX communications should be directed to (703) 746-5078. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman, Ph.D.  
Patent Examiner  
Art Unit 1652

 03-26-04